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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/626,876	07/24/2003	James E. O'Toole	MI40-356	2003
21567	7590	06/29/2005	EXAMINER	
WELLS ST. JOHN P.S. 601 W. FIRST AVENUE, SUITE 1300 SPOKANE, WA 99201			HOLLOWAY III, EDWIN C	
			ART UNIT	PAPER NUMBER
			2635	
DATE MAILED: 06/29/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/626,876

**Applicant(s)**

O'TOOLE ET AL.

**Examiner**

Edwin C. Holloway, III

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 253-277 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 253-277 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>07-24-03, 10-10-03, and 6-28-04</u> | 6) <input type="checkbox"/> Other: _____  |

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**EXAMINER'S RESPONSE**

1. In response to the application with preliminary amendment filed 1-29-04, the application has been examined. The preliminary amendment has been entered. The examiner has considered the presentation of claims in view of the disclosure and the present state of the prior art. And it is the examiner's opinion that the claims are unpatentable for the reasons set forth in this Office action:

***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

4. Claims 253-256 are rejected under 35 U.S.C. 103(a) as being

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unpatentable over Falk (US 4514731) or Caswell (US 5406297) in combination with Anders (US 4656463), Sharpe (US 5448242) or Hurta (US 5450087) and further in view of Pless (US 4868908) or Jones (US 5103156).

Falk discloses a wireless identification transponder or tag with detection of low battery voltage below a predetermine level and transmitting a battery status in response to interrogation. See the abstract, cols 1-2 and cols. 5-6. Caswell discloses a similar RF transponder low battery detection when battery value below a threshold an transmitting a battery status value in response to interrogation. See cols. 8, 10 , 19 and 21. Caswell do not specify a single IC with transmitter and receiver.

Anders discloses an analogous art transponder or passive transceiver (PT) which may be formed as a single IC RFID device with transmitter and receiver. The PT may respond to interrogation by an AT with an alert or status that battery needs recharged in col. 10. Sharpe and Hurta disclose analogous art transponders which may be formed as a single IC RFID device with transmitter and receiver. The transponder monitors battery capacity and responds to interrogation with a battery capacity status indication to provide low battery warning. See cols. 7, 17-18 and 25 of both patents.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Falk or Caswell a single IC RFID device because a single IC RFID device is disclosed in analogous art by Anders, Sharpe or Hurta which suggest the combination by disclosing transponder transmitting a battery status signal and because a single IC provides advantages such as reduce cost and size.

Alternatively, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in Anders, Sharpe or Hurta the battery status from comparison to a threshold as disclosed in analogous art by Falk or Caswell to be a simple manner to check the battery.

Pless discloses an analogous art low battery detection system with comparison to a reference voltage generated using bandgap. See cols. 3 and 6-8. Jones discloses an analogous art low battery detection system with comparison to a reference voltage generated using semiconductor bandgap. Col. 2 states that the battery monitoring is important in portable transceivers and on-chip bandgap reference is described as conventional and extremely useful in cols. 3-4. See cols. 2-8.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have included in the combination applied above the low battery detection with

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comparison to a reference voltage generated using a semiconductor or on-chip bandgap because this is disclosed in analogous art by Pless or Jones and is conventional and extremely useful for battery status monitoring.

### ***Double Patenting***

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 253-277 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6600428.

Although the conflicting claims are not identical, they are not patentably distinct from each other because claims 253-277 of the instant application are generally broader than claims 1-21 in Patent No. 6600428.

Broader claims in a later application constitute obvious double patenting of narrow claims in an issued patent. See *In*

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*re Van Ornum and Stang*, 214, USPQ 761, 766, and 767 (CCPA) (the court sustained an obvious double patenting rejection of generic claims in a continuation application over narrower species claims in an issued patent); *In re Vogel*, 164 USPQ 619, 622, and 623 (CCPA 1970) (generic application claim specifying "meat" is obvious double patenting of narrow patent claim specifying "pork").

The integrated circuit with low battery signal and band gap in claims 253-256 of the application is generally broader than claims 2 and 6 of Patent No. 6600428. Claims 257-277 are generally broader than claims 1-21, respectively, of Patent No. 6600428. If low battery signal in an "integrated circuit" is not clear in claims 2 and 6 of the patent, then it would have been obvious to one of ordinary skill in the art at the time the invention was made in view of the integrated circuit with battery status register in claims 3, 9, 14 and 20 of the patent. Claims 257 and 267 of this application include broader language of "a power-up signal" compared to the "first and second power up signals" in claims 1 and 11 of the patent. Claims 261 and 272 of this application include broader language of "a wake-up routine" compared to the "wake up program stored in the memory" in claims 5 and 16 of the patent.

#### **CONTACT INFORMATION**

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

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Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact an Electronic Business Center (EBC) representatives at 703-305-3028 or toll free at 866-217-9197 between the hours of 6 a.m. and midnight Monday through Friday EST, or by e-mail at [ebc@uspto.gov](mailto:ebc@uspto.gov). The Patent EBC is a complete customer service center that supports all Patent e-business products and service applications. Additional information is available on the Patent EBC Web site at <http://www.uspto.gov/ebc/index.html>.

Any inquiry of a general nature should be directed to the Technology Center 2600 receptionist at (571) 272-2600.

Prior to July 15, 2005, facsimile submissions may be sent via central fax number (703) 872-9306 to customer service for entry by technical support staff. Questions related to the operation of the facsimile system should be directed to the Electronic Business Center at (866) 217-9197. On July 15, 2005, the Central FAX Number will change to 571-273-8300. This new Central FAX Number is the result of relocating the Central FAX server to the Office's Alexandria, Virginia campus.

Most facsimile-transmitted patent application related correspondence is required to be sent to the Central FAX Number. To give customers time to adjust to the new Central FAX Number, faxes sent to the old number (703-872-9306) will be routed to the new number until September 15, 2005. After September 15, 2005, the old number will no longer be in service and 571-273-8300 will be the only facsimile number recognized for "centralized delivery".

**CENTRALIZED DELIVERY POLICY:** For patent related correspondence, hand carry deliveries must be made to the Customer Service Window (now located at the Randolph Building, 401 Dulany Street, Alexandria, VA 22314), and facsimile transmissions must be sent to the Central FAX number, unless an exception applies. For example, if the examiner has rejected claims in a regular U.S. patent application, and the reply to the examiner's Office action is desired to be transmitted by facsimile rather than mailed, the reply must be sent to the Central FAX Number. Inquiries concerning only hours and location of the Customer Window may be directed to OIPE Customer Service at (703) 308-1202.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edwin C. Holloway, III whose telephone number is (571) 272-3058. The examiner can normally be reached on M-F (8:30-5:00). If attempts to reach the examiner by telephone are unsuccessful,



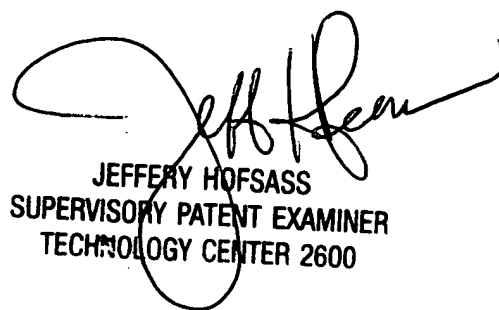
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the examiner's supervisor, Michael Horabik can be reached on  
(571) 272-3068.

EH  
6/23/05



EDWIN C. HOLLOWAY, III  
PRIMARY EXAMINER  
ART UNIT 2635



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